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OFFICE OF PETITIONS

32892.00024

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Eugenio A. Cefali
Application No. : 08/962,421 Confirmation No.:
Filed : October 31, 1997
For : INTERMEDIATE RELEASE NICOTINIC ACID
COMPOSITIONS FOR TREATING
HYPERLIPIDEMIA WHICH EXHIBIT AN IN
VIVO STAIR-STEPPED ABSORPTION CURVE
Group Art Unit : 1615
Examiner : James M. Spear

Hon. Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

Attn: OFFICE OF PETITIONS

**The documents filed herein must be kept
together as a unit and taken up in the order in
which they are detailed in the Petition to
Revive Unintentionally Abandoned Application
Under 37 C.F.R. § 1.137(b).**

**If the Office of Petitions has any
questions regarding these instructions, the**

Office is invited to contact the undersigned at
the information below.

Respectfully submitted,

Date: 1/15/03

K Messick
Karen J. Messick (Reg. No. 46,256)
Attorney for Applicant
c/o KOS Pharmaceuticals, Inc.
1001 Brickell Bay Drive
25th Floor
Miami, Florida 33131
Tel.: (305) 523-3643

#24

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REQUEST TO CORRECT INVENTORSHIP UNDER
37 C.F.R. § 1.48(a)

Sir:

Pursuant to 37 C.F.R. § 1.48(a)(1), applicant hereby requests the Commissioner to correct inventorship of the above-identified patent application by adding the name of David J. Bova as a co-inventor. In support of this Petition, applicant files concurrently herewith:

1) A Statement Under 37 C.F.R. § 1.48(a)(2) from
David J. Bova;

2) A Statement Under 37 C.F.R. § 1.48(a)(5) from
assignee's representative, Juan Rodriguez of Kos


Pharmaceuticals, Inc., the assignee of the above-identified patent application with Exhibit A--A copy of an executed Assignment from Eugenio A. Cefali, filed in the United States Patent and Trademark Office on April 6, 1998, in the above-identified patent application; and

3) A Declaration/Power of Attorney executed by the actual inventors as required by 37 C.F.R. § 1.63.

In the accompanying Transmittal Letter (submitted in duplicate herewith), the Director is authorized to charge \$130.00 in payment of the fee for this Request set forth in 37 C.F.R. § 1.17(i) and any additional fee required in connection with this Request, or to credit any overpayment, to Deposit Account No. 50-2543 (Kos).

Respectfully submitted,

Date: 1/15/03


Karen J. Messick (Reg. No. 46,256)
Attorney for Applicant
c/o Kos Pharmaceuticals, Inc.
1001 Brickell Bay Drive
25th Floor
Miami, Florida 33131
Tel.: (305) 523-3643

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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PETITION TO REVIVE
UNINTENTIONALLY ABANDONED APPLICATION
PURSUANT TO 37 C.F.R. § 1.137(b)

Sir:

Pursuant to 37 C.F.R. § 1.137(b), applicant hereby petitions to revive the above-identified patent application, which was unintentionally abandoned on December 27, 2000. The purpose of the revival is to: (1) submit the reply to the September 25, 2000 Notice of Allowance and Issue Fee Due and its attached Notice of Allowability, i.e., the issue fee (now resubmitted) and corrected formal drawings, which were required to allow this application to issue; (2) file a Request for

Continued Examination ("RCE") of this application under 37 C.F.R. § 1.114 and (3) have considered in the RCE the accompanying Request to Correct Inventorship of this application under 37 C.F.R. § 1.48.

The unintentional abandonment of the above-identified application was caused by applicant's inadvertent failure to include corrected formal drawings with the December 26, 2000 Issue Fee Transmittal. Had the corrected formal drawings been timely submitted, this application would have issued as a patent.

Pursuant to 37 C.F.R. § 1.137(b), this Petition is accompanied by:

- 1) The required issue fee transmittal;
- 2) The required corrected formal drawings (FIGS. 1-5) that should have been filed prior to or concurrently with submission of the issue fee;
- 3) A Declaration of Peter J. Manso in support of this Petition; and
- 4) A Declaration of Karen J. Messick in support of this Petition.

Pursuant to 37 C.F.R. § 1.137(c), this Petition is not accompanied by a Terminal Disclaimer. The above-identified

application is a utility application filed after June 8, 1995. Accordingly, no Terminal Disclaimer should be required.

This Petition is also accompanied by:

5) A Petition for Withdrawal from Issue under 37 C.F.R. § 1.313(c)(2); and

6) A Request for Continued Examination ("RCE") of the above-identified application under 37 C.F.R. § 1.114.

This Petition is also accompanied by:

7) A Request to Correct Inventorship Under 37 C.F.R. § 1.48;

8) A Statement of David J. Bova Under 37 C.F.R. § 1.48(a)(2) in Support of the Request to Correct Inventorship;

9) An executed Declaration/Power of Attorney from Eugenio A. Cefali and David J. Bova in the above-identified patent application;

10) A Consent of Assignee Under 37 C.F.R. § 1.48(a)(5) to the Request for Correction of Inventorship with Exhibit A--A copy of an executed Assignment from Eugenio A. Cefali, filed in the United States Patent and Trademark Office on April 6, 1998 in the above-identified application; and

11) A Request to Perfect Claim to Priority Pursuant to 35 U.S.C. § 120.

In the accompanying Transmittal Letter (filed in duplicate herewith), the Director is authorized to charge \$750.00 in payment of the RCE filing fee; \$130.00 in payment of the fee for consideration of this Petition; and any additional fee required in connection with this Petition, or any of the papers filed herewith, or to credit any overpayment of same, to Deposit Account No. 50-2543.


As indicated in the accompanying Manso and Messick declarations, the entire delay to date in filing the corrected formal drawings and resubmitting the issue fee in the above-identified application from the initial due date was unintentional. The undersigned attorney first became aware of the unintentional abandonment on or after October 16, 2002.

Accordingly, applicant requests that this Petition be granted and that the above-identified application be revived to allow filing of the issue fee and corrected formal drawings, putting the application in condition for withdrawal from issue

in favor of the Request for Continued Examination, in order to
reopen prosecution and allow consideration therein of the
Request to Correct Inventorship filed herewith.

Respectfully submitted,

Date: 1/15/83



Karen J. Messick (Reg. No. 46,256)
Attorney for Applicant
c/o Kos Pharmaceuticals, Inc.
1001 Brickell Bay Drive
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Examiner : James M. Spear

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DECLARATION OF PETER J. MANSO
IN SUPPORT OF PETITION TO REVIVE
UNINTENTIONALLY ABANDONED APPLICATION
PURSUANT TO 37 C.F.R. § 1.137(b)

Sir:

I, PETER J. MANSO, declare that:

1. I am of counsel to the law firm of Edwards & Angell, LLP. Until recently, I was the principal attorney of record in the above-identified application and am now associate attorney of record. I make this declaration in support of applicant's Petition to Revive Unintentionally Abandoned

Application Pursuant to 37 C.F.R. § 1.137(b), filed concurrently herewith.

2. I have reviewed the April 17, 2001 Notice of Abandonment, the December 26, 2000 Issue Fee Transmittal and the September 25, 2000 Notice of Allowance and Issue Fee Due and its attached Notice of Allowability and Examiner's Statement of Reasons for Allowance in the above-identified application.

3. As set forth in the April 17, 2001 Notice of Abandonment, the above-identified application went abandoned due to failure to timely file new formal drawings as required in the Notice of Allowability.

4. The failure to file new formal drawings with the December 26, 2000 Issue Fee Transmittal was unintentional. In the course of preparing to pay the issue fee, I instructed my secretary at my former law firm, Akerman, Senterfitt, Eidson, to prepare the Issue Fee Transmittal form for my signature. I specifically recall that the formal drawings were kept in the file of a related application, United States patent application Serial No. 08/962,424, which I was prosecuting at the time. Inadvertently, the formal drawings were omitted from the envelope containing the Issue Fee Transmittal as filed with the United States Patent and Trademark Office by certificate of

mailing procedure pursuant to 37 C.F.R. § 1.8(a)(1)(i)(A).

This omission was unintentional. At that time, I was the only attorney at Akerman, Senterfitt, Eidson responsible for patent prosecution matters of Kos Pharmaceuticals Inc., the assignee of the above-identified application. There was no Patent Department or docket clerk at Akerman, Senterfitt, Eidson reviewing submissions prior to their filing with the United States Patent and Trademark Office at that time.

5. When I left the employ of Akerman, Senterfitt, Eidson on January 31, 2001, I believed that no further action needed to be taken on my part in connection with the above-identified application and I expected a patent to issue in due course.

6. The April 17, 2001 Notice of Abandonment in the above-identified application was addressed to Akerman, Senterfitt, Eidson. I joined my current law firm, Edwards & Angell, LLP, in May of 2001.

7. After I left Akerman, Senterfitt, Eidson, the files for the above-identified application, as well as related applications I was prosecuting while at Akerman, Senterfitt, Eidson, were not immediately transferred to me. Instead, for the next few months, I received correspondence from my former firm relating to those applications. My receipt of such

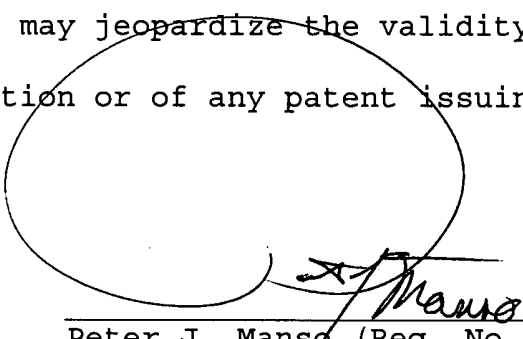
correspondence was complicated by the fact that my office at Edwards & Angell was relocated three times, involving three different mailing addresses. During that period, as well as through about the beginning of May, 2002, I maintained a manual docketing system for any such correspondence which required any responsive action to be filed with the United States Patent and Trademark Office, as Edwards & Angell was in process of implementing a new docketing system.

8. I was unaware of the April 17, 2001 Notice of Abandonment in the above-identified patent application from the time I joined Edwards & Angell until the week of October 21, 2002, when I learned of it from Karen J. Messick, in-house Intellectual Property Counsel for Kos Pharmaceuticals, Inc. I understand that Ms. Messick first became aware of the abandonment only after reviewing a copy of the official United States Patent and Trademark file for the above-identified application obtained following an authorized inspection. My file copy of the above-identified application as reconstructed from documents received from Akerman, Senterfitt, Eidson does not contain a copy of the April 17, 2001 Notice of Abandonment.

9. Based on all of the foregoing circumstances, the entire delay to date of the current submission of applicant's Petition to Revive Unintentionally Abandoned Application

Pursuant to 37 C.F.R. § 1.137(b), the issue fee and corrected formal drawings in the above-identified application was unintentional.

10. The undersigned further declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or of any patent issuing thereon.



Peter J. Manso (Reg. No. 32,264)
c/o Edwards & Angell, LLP
350 East Las Olas Boulevard
Suite 1150
Ft. Lauderdale, Florida 33301
Tel.: (954) 727-2600

Signed this 9th day
of January, 2003,
at Ft. Lauderdale, FL

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DECLARATION OF KAREN J. MESSICK
IN SUPPORT OF PETITION TO REVIVE
UNINTENTIONALLY ABANDONED APPLICATION
PURSUANT TO 37 C.F.R. § 1.137(b)

Sir:

I, KAREN J. MESSICK, declare that:

1. I am the Intellectual Property Counsel for Kos Pharmaceuticals, Inc. ("Kos"), the assignee of the above-identified patent application. I have held this position since November 5, 2001, when I joined the company. I am the principal attorney of record in the above-identified application, by virtue of a Power of Attorney and Re-

Designation of Principal Attorney of Record as Associate Attorney of Record effective November 20, 2002. I make this declaration in support of applicant's Petition to Revive Unintentionally Abandoned Application Pursuant to 37 C.F.R. § 1.137(b), filed concurrently herewith.

2. Prior to the time I began working at Kos, all of its patent prosecution matters were exclusively handled by outside patent counsel. Peter J. Manso, the prior principal attorney of record and current associate attorney of record in the above-identified application, was the outside patent counsel responsible for prosecution of those Kos patent prosecution matters relating to nicotinic acid, including the above-identified patent application.

3. On October 2, 2002, pursuant to my request, a representative from Cantwell & Paxton filed a Power to Inspect and Make Copies in the above-identified application, in order to obtain a complete copy of the official file wrapper of the application. I requested the inspection in order to verify whether Kos' in-house file for the application was complete. At that time, Kos' in-house file for the application did not contain the April 17, 2001 Notice of Abandonment.

4. I received a copy of the official file wrapper from Cantwell & Paxton on or after October 16, 2002. In reviewing the official file wrapper, I first became aware of

the April 17, 2001 Notice of Abandonment, the December 26, 2000 Issue Fee Transmittal and the September 25, 2000 Notice of Allowance and Issue Fee Due and its attached Notice of Allowability and Examiner's Statement of Reasons for Allowance in the above-identified application.

5. During the week of October 21, 2002, after reviewing the official file wrapper for the above-identified application and first learning of the abandonment, I contacted Mr. Manso to discuss it. Mr. Manso informed me that he was unaware that the application was abandoned.

6. As set forth in the April 17, 2001 Notice of Abandonment, the above-identified application went abandoned due to failure to timely file new drawings as required in the September 25, 2000 Notice of Allowability. On January 7, 2003, Mr. Manso informed me that the formal drawings were inadvertently omitted from the envelope containing the Issue Fee Transmittal filed in the application on December 26, 2000. Mr. Manso also informed me that given his submission of the issue fee in the application, he believed that no further action needed to be taken on his part and he expected a patent to issue in due course.

7. For the reasons set forth above, I believe that the entire delay to date of the current submission of applicant's Petition to Revive Unintentionally Abandoned

Application Pursuant to 37 C.F.R. § 1.137(b), the issue fee and corrected formal drawings in the above-identified application was unintentional.

8. The undersigned further declares that all statements made herein of her own knowledge are true and that all statement made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or of any patent issuing thereon.

K Messick

Karen J. Messick
Registration No. 46,256
C/O Kos Pharmaceuticals, Inc.
1001 Brickell Bay Drive
25th Floor
Miami, Florida 33131
Tel.: (305) 523-3643

Signed this 15 day

of January, 2003,

at Miami FL 33131

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Application No. : 08/962,421 Confirmation No: JAN 16 2003
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STATEMENT OF DAVID J. BOVA UNDER 37 C.F.R. § 1.48(a)(2)
IN SUPPORT OF REQUEST TO CORRECT INVENTORSHIP

Sir:

I, DAVID J. BOVA, hereby declare that:

1. I make this statement in support of the Petition
to Correct Inventorship Pursuant to 37 C.F.R. § 1.48(a), filed
in the above-identified patent application concurrently
herewith.

2. Due to an error in designating inventorship, I am not listed as a co-inventor of the above-identified patent application.

3. The error of failing to include my name as a co-inventor of the above-identified patent application occurred without any deceptive intention on my part.

4. I hereby further declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both, under Section 1001, Title 18, United States Code, and that such willful false statements may jeopardize the validity of the above-identified patent application, or any patent issuing thereon.

1/8/03

Date

David J. Bova

David J. Bova

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Eugenio A. Cefali

Application No. : 08/962,421 Confirmation No.:

Filed : October 31, 1997

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Examiner : James M. Spear

Hon. Commissioner for Patents
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STATEMENT OF JUAN RODRIGUEZ UNDER
37 C.F.R. §§ 1.48(a)(2) AND 3.73(b)
IN SUPPORT OF REQUEST TO CORRECT INVENTORSHIP

Sir:

I, Juan Rodriguez, am empowered to act on behalf of
Kos Pharmaceuticals, Inc., the assignee of the above-identified
patent application.

Kos Pharmaceuticals, Inc., a Florida corporation
having an office and place of business at 1001 Brickell Bay
Drive, 25th Floor, Miami, Florida 33131, is the assignee of the
entire right, title and interest in the above-identified
patent, by virtue of an Assignment from the presently named
inventor, Eugenio A. Cefali.

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A copy of an executed Assignment from Eugenio A. Cefali, in the above-identified application, which I am informed and believe was recorded in the United States Patent and Trademark Office on April 6, 1998 at Reel/Frame: ____/____, is attached hereto as Exhibit A.

Kos Pharmaceuticals, Inc. hereby consents to correction of the inventorship of the above-identified patent application by the addition of David J. Bova as a co-inventor with Eugenio A. Cefali.

KOS PHARMACEUTICALS, INC.

1/10/03
Date

By: Juan Rodriguez
Juan Rodriguez
Secretary and Vice President,
Controller
Kos Pharmaceuticals, Inc.